

(D) Remarks

Claim Numbering

The present application as filed included claims 1 - 11. A Preliminary Amendment was filed concurrently cancelling these claims and submitting new claims 12 - 27, of which claims 12, 24 and 27 were independent claims. In the Official Action dated January 31, 2003, the examiner indicated that claims 1 - 26 were pending but in the explanation of the restriction requirement indicated only claims 11- 22 and claims 23 - 26. In the response to this restriction requirement, the applicants elected the claims of Group II (claims 23 - 26) but in so doing requested that claim 27 also be added to this Group. Since there appears to be some confusion as to which claims are indeed pending, the applicants propose to cancel or withdraw all claims presented to date and present here new claims 28-43.

35 USC 112, first paragraph

The applicants submit that the specification is commensurate with the scope of the claims. While the specification only specifically names hematite as an example of a dense material for use in the invention, it is submitted that other materials are clearly comprised in the specification, as is clear from page 5, lines 19-27. Suitable weighting materials satisfying the preferred limitations are well-known in the art (see, for example, Well Cementing, 1990, Schlumberger Education Services, Ch. 3 Erik B Nelson, Jean-Francois Baret and Michel Michaux, pages 3-17 and 3-18, copy enclosed). Such can clearly be substituted for hematite without the need for undue experimentation and without changing that manner in which the invention operates, as would be immediately apparent to a person of ordinary skill in the art. It is submitted that the specification is enabling for hematite and equivalent materials known in the state of the art.

35 USC 112, second paragraph

The term "low compressibility" is now no longer found in the claims, being replaced by a specified Poisson ratio (this being the manner in which the desirable compressibility is defined in the specification).

The term "dense particles" is now no longer found in the claims, being replaced by a recitation of a particulate material having a specified density (this being the manner in which the dense particles are defined in the specification). As is discussed above in relation to 35 USC 112, first paragraph, such particles embrace more than hematite.

The Markush group "rubber and flexible materials" is no longer found in the claims. As the examiner correctly comments, rubber is a flexible material and so is presented as a separate dependent claim.

It is submitted that the new claims presented here address all of the issues identified by the examiner under 35 USC 112, second paragraph.

35 USC 103

The examiner has rejected all of the claims as obvious based on the disclosure of US 6,176,314. No other prior art or evidence has been presented by the examiner to support this rejection. The applicants submit that the invention defined in independent claims 28 and 43 presented here is not obvious. In both claims, the use of a particulate material having a specific gravity of greater than 3, and the use of reinforcing particles having a Poisson ratio of more than 0.3 are specified. Neither of these limitations can be found in the '314 reference, either explicitly stated or implicit in the properties of the materials disclosed.

The examiner makes two statements as to knowledge of the art in respect of elements of the invention, namely "...an extender selected from materials such as diatomite, ceramic beds, and silica spheres which are known in the art to have a higher density than cement or hydraulic binder. This is especially true for ceramic beads." (emphasis added); and "Also, Stephens may not teach the exact particle size but it would have been understood by one of ordinary skill in the art that a material that is ground certainly can include particle sizes smaller than 600 microns." (emphasis added). While the applicants accept that references do not have to explicitly suggest combining or modifying teachings,

examiner must present convincing line of reasoning supporting a rejection on the grounds of obviousness. The absence of any evidence supporting the examiner's position on these two points makes the reasoning unconvincing.

MPEP 2143 sets forth the basic requirements of a *prima facie* case of obviousness:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

As has been discussed above, the '314 reference does not teach or suggest all of the claim limitations and therefore the third of these criteria is clearly absent.

It is also submitted that the '314 reference contains no suggestion or motivation to modify its teachings to arrive at the presently claimed invention. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is nothing in the '314 reference to suggest the desirability of the presently claimed combination of elements.

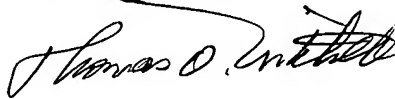
Furthermore, a statement that modifications of the prior art to meet the claimed invention would have been within the ordinary skill of the art because the references relied upon are alleged to teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). No objective reason has been provided by the examiner which supports the allegation of obviousness.

The only specific discussion of the disclosure of the '314 reference is in relation to its disclosure of extenders and if it is the examiner's position that such materials read onto the dense particles of the present claims the applicants disagree. Firstly, there is no discussion whatsoever of the extenders in the '314 reference having densities at or near the range now specified in the claims. Secondly, it is submitted that the state of the art is such that extenders are considered to be low density additives rather than high density ones, as is evidenced by the enclosed extract from Well Cementing, 1990, Schlumberger Education Services, Ch. 3 Erik B Nelson, Jean-Francois Baret and Michel Michaux, pages 3-1 to 3-18, in which extenders and weighting agents (dense materials) are considered separately, and the extenders are only considered in terms of reducing density of the slurry.

Applicants submit that this response addresses all of the issues raised in the official action and respectfully request reconsideration and that a timely Notice of Allowance will be issued in this case.

It is believed that no fee is due for this submission. However should a fee be due, the Commissioner is authorized to charge or credit any necessary fee to Deposit Account No. 50-2183(55.0209).

Respectfully submitted,



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